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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,963	12/04/2001	Marian Trinkel	520.1006	3493

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EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,963

Applicant(s)

TRINKEL, MARIAN

Examiner

Daniel I Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the IDS and Preliminary Amendment, both received on 4 December 2001. Claims 1-11 were cancelled per the Preliminary Amendment. Claims 12-24 are currently pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Re claim 12 and 20, it is unclear to the examiner what constitutes a "clacking noise".
3. Claim 23 recites the limitation "the element" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Appropriate clarification/correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12, 14-16, and 20-23, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuschel et al. (WO 99/34324).

Re claims 12 and 20, Kuschel et al. teaches a portable identification device including a signal generator device configured for generating a reproducible acoustic signal in a mechanical manner, a frequency spectrum of the clacking noise encoding information, the signal generator device including at least of a tongue, plate, or curved surface for generating the identifying acoustic signal acted upon mechanically, and a control unit configured for reading the encoded information and allowing a user to access the system once an identity of the device is established, through FIG. 1, where a reproducible signal is generated (mechanically) by inserting the card into a control unit 9, where the encoded information is read (col 1, lines 54-58) to allow access to a controlled system, for example a telephone network, via the control unit, once identification is established (col 4, lines 18-39). Further, Kuschel et al. teaches a tongue/plate/curved surface to create the sound, through raised bumps 3 of the profile 4, reader cams 6, and flexible prongs 5.

Re claims 14-16, the device includes a plastic card (dimensioned as a credit card) (see FIG. 1) and abstract.

Re claims 21-22, it has been taught above that the tongue/plate/curved surface responsible for the sound production is interpreted to include reader cam 6/flexible prong 5, which are interpreted to include a membrane body/resonator. It is well known and obvious therefore, that the shaping/size of the reader cam 6/ flexible prong 5, would inherently effect the frequencies (sound) at which the signals are generated, and therefore would effect the encoding, thus, the encoding is seen as a function of the shaping of those components.

Re claim 23, through FIG. 1, it is shown that the tongue/plate/curved surface is formed integrally on the device.

Kuschel et al. fails to teach the noise is a clacking noise, and that the tongue/plate/curved surface folds upon overcoming an initial resistance, and that the folding generating the clacking noise. However, at the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to use a clacking noise, or that the tongue/plate/curved surface folds and springs back upon actuation, as such structural amendments fall within the scope of what a person skilled in the art routinely does on the basis of familiar considerations, especially since the advantages achieved thereby can be readily foreseen. Further, such modifications are an obvious matter of design variations, since Kuschel et al. teaches generating an noise that encodes data. Simply specifying a different sound of the noise to encode data does not functionally distinguish itself from the prior art, as both means encode data acoustically, and the changing of the sound that is used to encode data is well within the ordinary skill in the art. Further, folding a tongue/plate/curved surface, as opposed to it bending, is an obvious matter of design variation, since both allow a resilient member to flex and spring back, and therefore are functionally equivalent as means for providing for a resilient member to create a acoustic signal. Simply changing the shape/direction of resiliency of a well-known resilient member is well within the ordinary skill in the art.

5. Claims 13 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuschel et al., as applied to claim 12 above, hereinafter Kuschel '324, in view of Kuschel et al. (DE-C-44 35 170), hereinafter Kuschel '170.

The teachings of Kuschel '324 have been discussed above.

Re claim 13, Kuschel '324 fails to teach that the control unit includes a microphone useable for feeding the acoustic signal to a computing unit configured for establishing the identification of the device. However, information cards that generate acoustic signals including encoded data that dial phone numbers, through the use of a microphone, are well known and conventional in the art. Specifically, Kuschel '170. teaches the use of a microphone as part of the control unit for supplying the acoustic signal to a computer unit (FIG 9), as is well known in the art. Further, at the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to include the microphone on the control unit, as a well known and conventional means of amplifying a signal's volume to provide a louder signal to reduce the chance of error in processing or not hearing the signal at all. Further, Mark (US 5,583,933) teaches the use of a microphone to apply an acoustic signal to a computing unit for verification via a computer (database), thus further demonstrating the obviousness of employing a well known microphone to increase a signal volume.

Re claims 17-19, according to the description of the known process to be carried out (column 4, lines 30-35 of Kuschel '170), it is clear that the identification medium forms a membrane body or a resonance body and that an acoustic PIN code can be entered in the control unit. Also, Kuschel '324 teaches that reader cams 6 mounted on flexible prongs 5 pass over the profile 4, and fall back after passing, thus striking the card surface or next bump, and creating a sound impulse. Therefore, the reader cam 6/flexible prongs 5 are interpreted to include a resonator/membrane, as they resonate to produce sound. Further, as Kuschel '324 teaches the encoding of information in via a profile that is read and outputted to a phone, it would have been obvious to encode a PIN number since it is well known to encode data on the profile and simply

specifying a type of data (PIN) is well within the ordinary skill in the art, especially since it is well known to encode a PIN, as Mark teaches the encoded acoustic transmission of a PIN code (col 56, lines 31+), which is used to facilitate the authorization of a phone card for telephone dialing use.

Therefore, at the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Kuschel '324 with those of Kuschel '170 in order to have a microphone to amplify the acoustic signal to make it more audible and therefore more likely to be detected for processing, as is well known and conventional in the art, and to also including a membrane body/resonator to transmit a code, as is well known and conventional in the art, for establishing identification access.

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuschel '324, in view of Mark.

The teachings of Kuschel '324 have been taught above. It is understood that the encoding of the information (generation of the acoustic signal) is performed by the user. Further, it is well known in the art that there are many encoding methods, and therefore the use of the encoding method as taught by Kuschel '324, performed by the user moving the card in the device, is seen as an encoding method selected from a predetermined plurality of encoding methods, since it is generally accepted that a finite number of encoding methods exist. Further, Mark teaches the information can be encoded by a user using an encoding method selected from a predetermined plurality of encoding methods through "In one embodiment, other tones or frequencies are also used to transmit data which cannot be detected by standard DTMF tone detectors" (col 6, lines 8+). This is interpreted to include the encoding, or representation of data,

in an alternative method, that is predetermined, since it is understood that when data cannot be detected, other tones or frequencies are used to encode and send the data. Though Mark is silent to the number or plurality of encoding methods, it is well known and understood that the use of other frequencies or tones, is interpreted to include a plurality of encoding methods, since a plurality of alternative frequencies/tones would be used, and that the encoding is done by the user actuating the device. Further, Mark teaches the use of pseudo random number generators to encode and transmit data (col 6, lines 12+) as an alternative encoding method, thus demonstrating various encoding methods. Therefore, the alternative frequencies/tones and the random number generator are interpreted to include encoding methods that the user would perform when encoding and sending data.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Kuschel '324 with those of Mark.

One would have been motivated to do this, to provide an encoding method that is user-friendly, as a user can encode the data themselves simply by moving a card in the housing or actuating the device.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Teicher et al. (US 6,257,486), Kuschel et al. (US 6,530,526), and Tsukuba (JP411234384A).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (703) 305-1001. The

examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[daniel.walsh@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

DIW
3/25/03



KARL D. FRECH
PRIMARY EXAMINER